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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,865	04/16/2004	Edgar Hommann	34206/US	8185

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David E. Bruhn, Esq.
DORSEY & WHITNEY LLP
Intellectual Property Department
50 South Sixth Street, Suite 1500
Minneapolis, MN 55402-1498

EXAMINER

GILBERT, ANDREW M

ART UNIT	PAPER NUMBER
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3767

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,865

Applicant(s)

HOMMANN ET AL.

Examiner

Andrew M. Gilbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgments

1. This office action is in reply to the response filed on 9/25/2006.
2. In the reply, the Applicant amended claim 1 and added new claims 11-17.
3. Additionally, the Applicant submitted formal drawings.
4. Thus, claims 1-17 are pending for examination. The information disclosure statement (IDS) submitted on 4/16/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pen-type injection device must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-7, 10-11, 13-16 rejected under 35 U.S.C. 102(b) as being anticipated by Jess et al (4210138). Jess et al discloses an injection device (10) comprising a capacitor as an energy storage device (Fig 8, 9, 189, 211), the capacitor being outside the body during such injection; a reservoir housing (16) a medicament; a drive system (40); a threshold value detector (col 8, Ins 37-col 9, Ins 27; col 13, Ins 1-27) coupled to the capacitor; a charge indicator being a voltmeter operably coupled to the capacitor (col 8, Ins 37-col 9, Ins 27; col 13, Ins 1-27; wherein the examiner notes an LED that responds to the voltage level acts as a voltmeter); a processor (14); at least one of a

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memory and a signal output device (col 8, Ins 37-col 9, Ins 27; col 13, Ins 1-27), said at least one of the memory and the signal output device supplied with current from the at least one capacitor (col 8, Ins 37-col 9, Ins 27; col 13, Ins 1-27); an electronic system includes sensing elements (col 8, Ins 37-col 9, Ins 27; col 13, Ins 1-27); further including control/processing elements and display elements capable of calculating and displaying the number of injections that can be performed based upon the power source (col 8, Ins 37-col 9, Ins 27; col 13, Ins 1-27; Figs 6-9); the capacitor being rechargeable (col 8, Ins 37-col 9, Ins 27; col 13, Ins 1-27; Figs 6-9).

8. Claims 1, 3-8, 10-11, 13-16 rejected under 35 U.S.C. 102(b) as being anticipated by Heilman et al (3701345). Heilman et al discloses an injection device (Fig 1) comprising a capacitor as an energy storage device (256; Fig 5, col 11, Ins 55-col 12, Ins 44), the capacitor being outside the body during such injection; a reservoir housing (Fig 1) a medicament; a drive system (Fig 1); a threshold value detector (col 6, Ins 13-54; col 15, Ins 61-65; col 19, Ins 54-66) coupled to the capacitor; a charge indicator being a voltmeter operably coupled to the capacitor (col 6, Ins 13-54; col 15, Ins 61-65; col 19, Ins 54-66); a processor (72); at least one of a memory and a signal output device (col 6, Ins 13-54; col 15, Ins 61-65; col 19, Ins 54-66) and said at least one of the memory and the signal output device supplied with current from the at least one capacitor, an electronic system includes sensing elements (col 6, Ins 13-54; col 15, Ins 61-65; col 19, Ins 54-66; col 14, Ins 15-20); further including control/processing elements and display elements capable of calculating and displaying the number of

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injections that can be performed based upon the power source (col 6, Ins 13-54; col 15, Ins 61-65; col 19, Ins 54-66; col 14, Ins 15-20); the capacitor being rechargeable (256; col 11, Ins 55-col 12, Ins 44).

9. Claims 1, 3-7, 10-11, 13-17 rejected under 35 U.S.C. 102(b) as being anticipated by Mulhauser et al (5919167). Mulhauser et al discloses an injection device (Fig 1-2) comprising a capacitor as an energy storage device (126; col 5, Ins 30-50; Fig 7), the capacitor being outside the body during such injection; a reservoir housing (26) a medicament; a drive system (84); a threshold value detector (col 5, Ins 30-50) coupled to the capacitor; a charge indicator being a voltmeter operably coupled to the capacitor (126; col 5, Ins 30-50; Fig 7); a processor (122); at least one of a memory and a signal output device (col 5, Ins 30-50), said at least one of the memory and the signal output device supplied with current from the at least one capacitor (col 5, Ins 30-50); an electronic system includes sensing elements (126; col 5, Ins 30-50; Fig 7); further including control/processing elements and display elements capable of calculating and displaying the number of injections that can be performed based upon the power source (126; col 5, Ins 30-50; Fig 7; wherein the user selected number of charges indicates that the controller can select and determined the number of charges, ie injections, that can be performed); the capacitor being rechargeable (126; col 5, Ins 30-50; Fig 7); wherein the injection device is a pen-type injection device (Fig 1, 2).

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10. Claims 1, 3-7, 10-11, 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Cable et al (4685903). Cable et al discloses an injection device (Abstract; Fig 1) comprising a duplex capacitor as an energy storage device (col 7, Ins 45-46), the capacitor being outside the body during such injection; a reservoir housing (5) a medicament; a drive system (12); a threshold value detector (16; col 5, Ins 28-47) coupled to the capacitor; a charge indicator being a voltmeter operably coupled to the capacitor (col 5, Ins 28-47; 40); a processor (18); at least one of a memory and a signal output device (col 4, Ins 53-55), said at least one of the memory and the signal output device supplied with current from the at least one capacitor (col 5, Ins 28-47; col 4, Ins 53-55; col 9, Ins 36-44); an electronic system includes sensing elements (16); further including control/processing elements and display elements capable of calculating and displaying the number of injections that can be performed based upon the power source (16, col 5, Ins 28-47, col 4, Ins 53-55, col 9, Ins 36-44); the capacitor being rechargeable (col 5, Ins 28-47; col 4, Ins 53-55; col 9, Ins 36-44; Abstract).

11. Claims 1, 3, 9, 11-13, 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Avarhami et al (6708060). Avarhami et al discloses an injection device (Fig 1a, b) comprising a duplex capacitor as an energy storage device (col 18, Ins 19-23; col 20, Ins 47-55; col 21, Ins 41-49), the capacitor being outside the body during such injection; a reservoir housing (Fig 1a, b; 40) a medicament; a drive system (Summary); an electronic system including inductive charging elements (col 18, Ins 19-

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23; col 20, lns 47-55; col 21, lns 41-49; Fig 9); the capacitor being rechargeable (216); and an electronic system includes sensing elements (Summary).

12. Claims 1 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hjertman et al (6042571). Hjertman et al discloses an injection device (Fig 6b) comprising a capacitor as an energy storage device (col 9, lns 40-45), the capacitor being outside the body during such injection; a reservoir housing (61) a medicament; a drive system (64); wherein the injection device is a pen-type injection device (Fig 6b).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jess et al. Jess et al discloses the invention substantially as claimed except for expressly disclosing that the capacitor is made out of gold. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the capacitor as taught by Jess et al with a gold capacitor since it was well known in the art that capacitors are made out of gold material. The Examiner further notes the rejection of claim 2 could also be made for the other prior art references discussed above.

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15. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jess et al in view of Portner et al (4360019). Jess et al discloses the invention substantially as claimed except for expressly disclosing a DC/DC converter operably coupled to the at least one capacitor. Portner et al teaches that it is known to have a DC/DC converter operable coupled to the at least one capacitor (col 9, lns 13-15) for the purpose of charging the capacitor to a voltage matching the required voltage from the motor. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the capacitor as taught by Jess et al with the DC/DC converter as taught by Portner et al for the purpose of the purpose of charging the capacitor to a voltage matching the required voltage from the drive member. The Examiner further notes the rejection of claim 8 in view of Portner et al could also be made for the other prior art references discussed above.

Response to Arguments

16. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Flaherty (6692457); Leslie et al (4529401); Whitney et al (4150672).

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18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571) 272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Gilbert

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

